THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte SHARAM HEKMATPOUR,
DAVID A. HODSON and DAVID J. MANN

_____

Appeal No. 96-0538
Application 08/126,450[1]

_____

ON BRIEF

_____

Before THOMAS, HAIRSTON and BARRETT, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 4, 7 through 11, 13 through 16, 18 and 20. Inasmuch as the application was filed without a claim 7, only claims 1 through 4, 8

[1] Application for patent filed September 24, 1993. According to the appellants, the application is a continuation of Application 07/773,372, filed October 7, 1991.

through 11, 13 through 16, 18 and 20 are before us on appeal.

The disclosed invention relates to a user interface system and method for electronically arranging the components of a special effects job for a motion picture production from a plurality of image sequences obtained by the scanning of motion picture film.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A user interface system for electronically arranging the components of a special effects job for a motion picture production from a plurality of image sequences obtained by the scanning of motion picture film, said system comprising:

a) a virtual light box interface for lining up the components of the special effects job, said virtual light box interface comprising:

means for ordering a plurality of image sequences into background and foreground image sequences, each sequence being composed of frames that imitate the frames of a motion picture film;

means for displaying the image sequences adjacent to each other so that the frames thereof visually align on a frame-to-frame basis; and

means providing for user variation of the adjacency of the image sequences so that different frames thereof are brought into visual alignment with each other, such that the image sequences are ordered by the user as to adjacency for one or more special effects; and

b) a flow graph interface visually displaying the type and order of special effects-process operations applied to the frames, said flow graph interface providing for user specification and control of what operations are to be performed and in what order the operations are applied to the components of the special effects job.

The references relied on by the examiner are:

Barndt	3,006,993	Oct. 31, 1961

Ghosh et al. (Ghosh)	4,498,079	Feb. 5, 1985
Kellar et al. (Kellar)	4,602,286	July 22, 1986
Ichinose	4,612,569	Sept. 16, 1986

Claims 1 through 4, 8 through 11, 13 through 16, 18 and 20 stand rejected under the first paragraph of 35 U.S.C. § 112 for failing to adequately teach how to make and/or use the invention.

Claims 1 through 4, 8 through 11, 13 through 16, 18 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kellar in view of Ichinose, Barndt and Ghosh.

Reference is made to the briefs and the answer for the respective positions of the appellants and the examiner.

OPINION

We have carefully considered the entire record before us, and we will reverse the rejections.

Turning first as we must to the rejection of the claims under 35 U.S.C. § 112, the examiner has questioned the enablement of the flow graph display component (Figure 4) of the disclosure (Answer, pages 3 and 4). Appellants disclose that the icons in the flowgraph display are formed by algorithms (specification, pages 12 and 13), and that the individual algorithms are known in the art (specification, pages 10, 14 and 15). Appellants have not disclosed a flowchart or program for integrating all of the algorithms into the flowgraph. For this reason, we are of the opinion that the examiner had a reasonable basis for questioning the adequacy of the disclosure.

The test for enablement under the first paragraph of 35 U.S.C. § 112 is whether the skilled

artisan could make or use the claimed invention from the disclosed subject matter together with information in the art without undue experimentation. United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert denied, 490 U.S. 1046 (1989). A disclosure can be enabling even though some experimentation is necessary. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987). Accordingly, we have to determine whether an undue amount of experimentation would be needed to integrate all of the known algorithms into the disclosed flowgraph. In re Vaeck, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991).

When the disclosed and claimed invention is considered as a whole, we find that some experimentation would be required to integrate the functionally disclosed algorithms into the flowgraph. We do not, however, believe that an undue amount of experimentation would be needed to tie the algorithms together into a composite algorithm for making composite images. In the absence of express reasons by the examiner as to why undue experimentation would be needed to arrive at such a composite algorithm, we do not agree with the examiner's conclusion (Answer, page 4) that "a compositing algorithm is necessary to the claimed invention and is mandatory according to 35 USC 112, paragraph 1." Thus, the lack of enablement rejection is reversed because the "compositing algorithm" may be arrived at with a reasonable amount of experimentation, and the scope of the claims bears a reasonable correlation to the scope of enablement provided by the disclosure. Genentech, Inc.

v. Novo Nordisk A/S, 108 F.3d 1361, 1365, 42 USPQ2d 1001, 1004 (Fed. Cir.), cert denied, 118 S.Ct. 397 (1997).

Turning to the rejection of the claims under 35 U.S.C. § 103, we agree with the examiner (Answer, page 4) that Kellar discloses compositing of images 30 and 31 (Figure 2), with one image in the foreground and another image in the background. We also agree with the examiner (Answer, page 4) that Kellar does not disclose "the images being displayed before the composed image is generated." In view of Kellar's foreground and background scene teachings (column 5, lines 17 through 45; and column 7, lines 13 through 20), we do not agree with appellants' argument (Brief, page 16) that "Kellar et al. never displays foreground and background scenes on the same display for any purpose whatsoever." We do, however, agree with appellants' argument (Brief, page 16) that Kellar does not provide "any technique for user specification and control and visual display of the type and order of operations applied to the frames in the sequences."

The examiner is of the opinion (Answer, page 5) that "Barndt had disclosed at the time that the invention was made that images on a storage means 44 could be placed on a display means 40," but appellants correctly concluded (Brief, page 16) that "'the storage means 44, is actually a mask 44 with preprinted images (silhouettes) that are scanned by a flying spot scanner CRT 40 in order to generate a keyer control signal that switches two video programs in a keyer 74," that "[t]he CRT 40 is not a display means, and the silhouette images in the mask 44 are not placed on the CRT 40," and that

"[i]nsofar as Barndt is understood, it would seem to have no relevance to the claimed invention."

According to the examiner (Answer, page 5), Ichinose shows that "images (Fig. 5) from a memory 25 could be generated on a display means 1," and that "such images can be interchanged (col. 2, line 60)." Notwithstanding such teachings in Ichinose, we agree with appellants' argument (Brief, page 17) that Ichinose would not have suggested "visually displaying the user specified type and order of operations applied to the frames."

Turning lastly to Ghosh, we agree with appellants' argument (Brief, page 18) that "[t]his prior art patent includes selection means for controlling the priority of display of overlaid objects but such prioritization is not controlled by the user," and that "[t]here is no teaching or suggestion in this reference of the claimed flow graph interface for user specification and control and visual display of the type and order of special effects - process operations."

Based upon the foregoing, appellants correctly concluded (Brief, page 18) that "combining the teachings of the applied reference[s] would still not produce the invention as defined in Appellants' independent claims." The obviousness rejection of the claims is reversed.

DECISION

The decision of the examiner rejecting claims 1 through 4, 8 through 11, 13 through 16, 18 and 20 under the first paragraph of 35 U.S.C. § 112 and 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
LEE E. BARRETT	)	

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